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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,837	03/26/2004	Blayn W. Beenau	70655.0100	2836
66170 7590 04/23/2007 AMERICAN EXPRESS TRAVEL RELATED SERVICES CO., INC. c/o SNELL & WILMER, L.L.P. ONE ARIZONA CENTER 400 E. VAN BUREN STREET PHOENIX, AZ 85004-2202			EXAMINER WALSH, DANIEL I	
			ART UNIT 2876	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	DELIVERY MODE
3 MONTHS			04/23/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/708,837

Applicant(s)

BEENAU ET AL.

Examiner

Daniel I. Walsh

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 2-07.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Receipt is acknowledged of the RCE received on 1-30-07 and IDS's of 2-13-07.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear which transponder is being referred to in the claim, as the base claim (claim 1) refers to first and second transponders. For purposes of Examination, the Examiner interprets the claim to mean that if the first sample is rejected a second sample is provided, such as when a first attempt has an error, permitting the users to retry with a second sample (which can be the same biometric, just a different attempt, which is interpreted as a second sample, as the first sample was rejected).

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-12, 14-17, 26, 30, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Black (US 2005/0122209) in view of Elledge (US 6,609,656). Re the pending claims, the Examiner notes that Black teaches a transponder can be a smartcard (paragraph [0014]) for example.

Re claim 1, Black teaches a transponder configured to communicate with a reader, a reader configured to communicate with the system, a biometric sensor configured to detect a first proffered biometric sample (signature) and a second proffered biometric sample (fingerprint), the sensor configured to communicate with the system, and a device configured to verify the samples facilitate a transaction (abstract and FIG. 1A).

Though Black is silent to a first and second transponder physically associated, the Examiner notes that it is obvious that the system of Black is used in an environment, which includes many users and transponders. Accordingly, it would have been obvious to have at least two transponders (associated via the same system, manufacturer, credit company, etc), for a multi-user system. Therefore it would have been obvious that as being distinct they would be

responding to distinct/different signals. By having a plurality of transponders in an area, such as a store, for a related/associated reason, such as purchasing, for example, the transponders would be broadly interpreted as associated physically, based on their common location/proximity for purchasing within an environment, for example. The Examiner notes that the claims do not require that one tag include two transponders responding to different frequencies, for example. The claims merely recite two physically associated transponders, which is broadly interpreted as being met when a plurality of transponders are physically in the same environment/location. The Examiner notes that the biometric sensor has been discussed above, and is interpreted to control an order of an operation to activate the transponder to complete a transaction.

Though Black is silent to a first and second transponder, the Examiner notes that it is obvious that the system of Black is used in an environment, which includes many users, locations, and transponders (system). Accordingly, it would have been obvious to have at least first and second transponders, and that as distinct transponders they would be responding to distinct/different signals. The Examiner notes that as the biometric sensor has been discussed above, it is interpreted to control an order of an operation, interpreted as the functioning of the transponder in the system to facilitate the transaction, thereby functioning as a switch to permit a transaction (yes) when appropriate and to reject (no) when no appropriate (not authenticated, for example). As the sample is matched to a sample, a verification device is interpreted to be present.

Black is silent to an authentication circuit to authenticate the interrogation signal.

The Examiner notes that mutual authentication, authentication of signals, etc. is well known in the art for security purposes. Nonetheless, Elledge teaches the RFID authenticates the interrogation signal (claim 26).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black with those of Elledge.

One would have been motivated to do this for enhanced security.

Re claim 2, the sensor is configured to communicate with the system via at least one of a transponder, reader, and network (FIG. 1A).

Re claim 3, the signature scan sensor is configured as a switch since it is used for yes/no access.

Re claim 4 and 30, Black teaches the sensor is configured as a switch, as discussed above. Though silent to selectivity modes and inclusivity modes, the Examiner notes that such terms are sufficiently vague, and the claims do not recite structural or specific details as to what constitutes such modes. Accordingly, the mere use of the transponder in the completion of a transaction can broadly be interpreted as one of the modes.

Re claims 5-6 and 33 Black teaches (col 6, lines 56+) that the customer record can be stored locally or remotely. Though silent to a datapacket stored on a database, Black teaches the customer record can include biometric information, user information, etc. (FIG. 5A+ for example), which is interpreted as a datapacket. It would have been obvious to store such information on a database, in order to have a well-known and conventional means of storing data for retrieval and organization. It would have been obvious to store the data remotely (or locally) based on security needs, as recognized in the art.

Re claim 7, it has been discussed above that samples are received and stored (database) for providing security/authentication. It would have been obvious to one of ordinary skill in the art that such samples would be received by an authorized sample receiver in order to ensure security and reliability.

Re claim 9, it has been discussed above that a comparison is performed. The Examiner notes that it would have been obvious to one of ordinary skill in the art to use a microprocessor/controller/processor (interpreted as a local CPU) to electronically perform the comparison, in order to have an electronic (automated) means to quickly and reliably perform the comparison, as is conventional in the art.

Re claim 8, the proffered sample is compared to a stored sample to verify the signatures/biometric, as discussed above.

Re claim 10, as the sample is stored, its interpreted as registered.

Re claim 11, Black teaches that a customer's account is linked to the biometric/signature data and can be used for payment and is linked to a credit or debit account (col 6, lines 46+ and abstract).

Re claim 12, the system of Black can be used by numerous individuals, who inherently have different information. Therefore Black is believed to teach different samples (different people) and therefore different accounts/information being associated.

Re claim 14, as Black teaches that access is only granted when the samples match, it would have been obvious to one of ordinary skill in the art to authenticate the samples upon verification, to control access when only valid samples are received.

Re claim 15, Black teaches such limitations (FIG. 6A).

Re claim 16, it has been discussed above that the device facilitates a financial transaction.

Re claims 17 and 26, the Examiner notes that such procedures (PIN, codes, passwords, etc) are all well known and conventional in the art for increased security. The Examiner notes that Black teaches the capture of biometrics, metrics, and signatures (FIG 1A), which is interpreted as a secondary security procedure from the two samples, used in the verification process.

4. Claims 1 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saito et al. (US 2004/0129787), as discussed above, in view of Elledge, as discussed above.

Saito et al. teaches a credit card with a fingerprint sensor disposed thereon (abstract, FIG. 1+), and that can be wirelessly communicated/RF (radio frequency). The other limitations have been discussed above in the discussion of Black, above, and are applicable here, as obvious to one of ordinary skill in the art for a transponder system.

Saito et al. is silent to the authentication circuit as discussed above.

Elledge teaches such limitations as discussed above.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Saito et al. wit those of Elledge.

One would have been motivated to do this for security.

Though silent to a first and second transponder physically associated, the Examiner notes that it is obvious that the system of Saito et al. is used in an environment, which includes many users and transponders. Accordingly, it would have been obvious to have at least two transponders (associated via the same system, manufacturer, credit company, etc), for a multi-user system. Therefore it would have been obvious that as being distinct they would be



responding to distinct/different signals. By having a plurality of transponders in an area, such as a store, for a related/associated reason, such as purchasing, for example, the transponders would be broadly interpreted as associated physically, based on their common location/proximity for purchasing within an environment, for example. The Examiner notes that the claims do not require that one tag include two transponders responding to different frequencies, for example. The claims merely recite two physically associated transponders, which is broadly interpreted as being met when a plurality of transponders are physically in the same environment/location. The Examiner notes that the biometric sensor has been discussed above, and is interpreted to control an order of an operation to activate the transponder to complete a transaction.

Re claim 15, though silent to detecting a second sample after rejection, the Examiner notes that it would have been obvious to permit a user a second chance, if the biometric sample first provided was not accepted (user error, bad scan, etc.). Accordingly, if a first sample were rejected, it would have been obvious for the smartcard/transponder to permit a second try/second biometric to be applied as convenience.

Additionally, the Examiner notes it is well known and conventional in the art to interrogate or query the transponder/smartcard by the host so that the card can reply to facilitate the transaction.

5. Claims 18-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Black, as discussed above.

Re claim 18, the limitations have been discussed above (abstract, FIG. 1A, and as discussed above).

Re claim 19, the Examiner has interpreted that the system is used with many different users and hence said first and second samples would be registered with an authorized sample receiver for security.

Re claim 20, the Examiner notes that registering includes proffering the same (abstract, FIG. 5A, as discussed above).

Re claim 21, the Examiner has interpreted the registering to include proffering a second biometric to the authorized sample receiver, as discussed above, as can be part of a different individual.

Re claim 22, the Examiner notes that proffering includes initiating at least one of storing, comparing, and verifying the sample, as discussed above.

Re claim 23, the limitations have been discussed above re claim 6. The Examiner notes that a database is an obvious expedient, and that processing such information contained in at least the transponder/reader/sensor/server/reader system is an obvious expedient to reliably authenticate a user during the attempted transaction.

Re claim 24, it has been discussed above that a proffered sample is compared with a stored sample.

Re claim 25, the Examiner notes that Black teaches (FIG. 4A) that a registration processor and print processor are used. As discussed above, it would have been obvious to one of ordinary skill in the art to use a local CPU in order to provide an electronic/automated/reliably means to accurately verify a sample, as is conventional in the art (see above). The comparisons have also been discussed above (proffered with a stored).

Re claim 26, though silent to secondary security procedures, the Examiner notes that secondary security procedures (PINs, codes, additional biometric samples, image matching, etc.) are well known in the art to provide additional security for authentication of an individual, and therefore is an obvious expedient.

Re claim 27, the limitations have been discussed above.

Re claim 28, Black teaches that the samples are detected at least at one of a transponder/reader/network (FIG. 1A-1C).

Re claim 29, it has been discussed above that a transaction is completed if the samples are verified, and this is interpreted as enabling the transponders.

Re claim 30, the limitations have been discussed above re claim 4.

Re claim 31, Black teaches logging each sample by a transaction record (paragraph [0125]), and as discussed above.

Re claim 32, the limitations have been discussed above re claim 11.

Re claim 33, the limitations have been discussed above including comparing a first proffered sample with a stored sample (with a card member) as during authentication of the card member.

Re claim 34, the Examiner notes that verifying the sample using information contained on one of a local database/remote database/third party controlled database would have been an obvious expedient in instances where the data is stored remote from the transponder, as discussed above, for security concerns. A remote database provides a preferred means to organize data for efficient and easy storage and retrieval, and is conventional in the art.

Re claim 35, the limitations have been discussed above re claim 9.

6. Claims 1 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Black/Elledge, as discussed above, in view of Martizen et al. (US 2002/0191816).

The teachings of Black/Elledge have been discussed above.

Black/Elledge is silent to different samples (of the same person) associated with a different one of personal information, credit card information, etc.

Martizen et al. teaches different biometric samples associated with different personal information (different fingers with different accounts) (FIG. 6A).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black/Elledge with those of Martizen et al.

One would have been motivated to do this in order to permit multiple accounts to be accessed with personalized security.

Though Martizen et al. is drawn towards different fingerprints, the Examiner maintains that it is well known and conventional in the art that different biometrics can be used to control access (voice, fingerprints, retina scans, signatures, etc). Accordingly, the Examiner believes that Martizen can be relied upon for the teachings of different samples to control access, where the type of biometric sample chosen, would have been obvious to one of ordinary skill in the art, given that there are numerous recognized and interchangeable biometrics that are accepted to control access.

7. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Black/Elledge/Martizen et al., as discussed above, in view of Moebs et al. (US 2005/0065872).

Re claim 16, the teachings of Black/Elledge/Martizen et al. have been discussed above.

Martizen et al. teaches a biometric sample is associated with at least one of a first user account, wherein the first account comprises personal information, credit card information, etc. and the first account is different than the second account (different samples), but it silent to primary and secondary associating.

Moebs et al. teaches that a customer can avoid overdraft by preauthorized the institution to tie the customers checking account into the other accounts (paragraph [0017]). The Examiner notes that such protection is well known in the art, and is interpreted to include primary and secondary associating. It would be obvious for the accounts to have the information in order to keep track and identify them.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black/Elledge/Martizen et al. with those of Moebs et al. for overdraft protection, for example.

8. Claims 1-13, 14-17, 26, 30, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Black/Elledge, as discussed above, in view of Steeves (US 2006/0071756).

The teachings of Black/Elledge have been discussed above.

Black/Elledge teach a transponder, but not two transponders of one device responding to different signals.

The Examiner notes that dual mode tags/transponders, which respond to different signals, are conventional in the art. Specifically, Steeves teaches (abstract) that a radio tag has two receivers in order to communicate with two different frequencies.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black/Elledge with those of Steeves.

One would have been motivated to do this in order to use more bandwidth by expanding the frequencies used by the tags. This can also reduce in interference and can increase efficiency of the system

The limitations of the dependent claims have been discussed above.

9. Claims 1 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saito et al./Elledge, as discussed above, in view of Steeves.

The teachings of Saito et al./Elledge have been discussed above.

Saito et al./Elledge teach a transponder, but not two transponders of one device responding to different signals.

The Examiner notes that dual mode tags/transponders, which respond to different signals, are conventional in the art. Specifically, Steeves teaches (abstract) that a radio tag has two receivers in order to communicate with two different frequencies.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Saito et al./Elledge with those of Steeves.

One would have been motivated to do this in order to use more bandwidth by expanding the frequencies used by the tags. This can also reduce in interference and can increase efficiency of the system

The limitations of claim 15 have been discussed above.

10. Claims 18-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Black, as discussed above, in view of Steeves.

The teachings of Black have been discussed above.

Black teaches a transponder, but not two transponders of one device responding to different signals.

The Examiner notes that dual mode tags/transponders, which respond to different signals, are conventional in the art. Specifically, Steeves teaches (abstract) that a radio tag has two receivers in order to communicate with two different frequencies.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black with those of Steeves.

One would have been motivated to do this in order to use more bandwidth by expanding the frequencies used by the tags. This can also reduce in interference and can increase efficiency of the system

The limitations of the depending claims have been discussed above.

11. Claims 1 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Black/Elledge/Martizen et al., as discussed above, in view of Steeves.

The teachings of Black/Elledge/Martizen et al. have been discussed above.

Black teaches a transponder, but not two transponders of one device responding to different signals.

The Examiner notes that dual mode tags/transponders, which respond to different signals, are conventional in the art. Specifically, Steeves teaches (abstract) that a radio tag has two receivers in order to communicate with two different frequencies.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black/Elledge/Martizen et al. with those of Steeves.

One would have been motivated to do this in order to use more bandwidth by expanding the frequencies used by the tags. This can also reduce in interference and can increase efficiency of the system

The limitations of the claim 12 have been discussed above.

12. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Black/Elledge/Martizen et al./Moebs, as discussed above, in view of Steeves.

The teachings of Black/Elledge/Martizen et al./Moebs have been discussed above.

Black teaches a transponder, but not two transponders of one device responding to different signals.

The Examiner notes that dual mode tags/transponders, which respond to different signals, are conventional in the art. Specifically, Steeves teaches (abstract) that a radio tag has two receivers in order to communicate with two different frequencies.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black/Elledge/Martizen et al./Moebs with those of Steeves.

One would have been motivated to do this in order to use more bandwidth by expanding the frequencies used by the tags. This can also reduce in interference and can increase efficiency of the system



***Response to Arguments***

13. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection. The Examiner has interpreted "physically associated" as not requiring the first and second transponder to be attached, but can include the location of transponders physically in an associated area/environment to each other. Such proximity is understood to include physical association.

***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (See PTO-892).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel I. Walsh whose telephone number is (571) 272-2409. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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D. Walsh

Daniel I Walsh  
Examiner  
Art Unit 2876  
4-9-07

A handwritten signature in black ink, appearing to read 'D. I. Walsh', with a stylized, cursive script.

DANIEL WALSH  
PRIMARY EXAMINER